RESPONSE AND REMARKS

AMENDMENTS TO THE SPECIFICATION

Amendments to the Specification are submitted herewith to delete the section title "FIELD OF THE INVENTION" immediately following the title of the application, and paragraph [0001] of the application as filed so that the "CROSS REFERENCE TO RELATED APPLICATIONS" section is the first section in the application in accordance with 37 C.F.R. §1.78; because the Claim of Priority was submitted in the Declaration filed with the application and with the transmittal letter filed with the present application, and because the Claim of Priority was recognized in the official Filing Receipt for the present application, then according to MPEP § 201.11 III.D, no petition or surcharge is due.

INFORMATION DISCLOSURE STATEMENTS

In the Office Action, the Examiner found that an Information Disclosure Statement, identified by the Examiner as having been filed on January 4, 2002, failed to comply with 37 C.F.R. 1.98(a)(2) as failing to provide a legible copy of each cited reference. The Examiner interpreted the objected-to Information Disclosure Statement as submitting redacted copies of certain references. The Examiner included copies of the objected-to PTO FORM1449 showing the reference listings lined-through.

In response to the Examiner's objections concerning the referenced Information Disclosure Statement, it is respectfully submitted that the referenced Information Disclosure Statement did not reference redacted copies of references. Rather, the referenced Information Disclosure Statement submitted PTO FORMS 1449 that were filed under seal in the case of the present application, which was subject to publication and, therefore, to public access. The objected-to PTO FORMS 1449 that the Examiner lined through were cover copies of corresponding unredacted PTO FORMS 1449 that were filed under seal. The objected-to PTO FORMS 1449 reflected redaction of information concerning certain cited references (namely, serial numbers and other information regarding co-pending applications that were not subject to publication

or to public access) -- the references themselves were not redacted. Unredacted copies of the corresponding PTO FORMS 1449 that were filed under seal were initialed by the Examiner and included with the Office Action.

On the first page of PTO FORMS 1449, the Examiner lined through two references identified as Declarations by JOHN DIETZ. The Examiner did not give any reason for lining through those two references. It is respectfully requested that the Examiner initial those two references and provide an initialed copy of the PTO FORM 1449 with the next Office communication.

CLAIM REJECTIONS UNDER 35 U.S.C. §112.

In the Office Action, the Examiner rejected Claims 5-21, 43-59, 81-97 and 119-135 under 35 U.S.C. §112 on the grounds that insufficient antecedent basis was recited for the limitation "the user" in Claims 5, 43, 81, and 119.

The Examiner's rejections under 35 U.S.C. §112 have been carefully considered. Claims 1, 39, 77, and 115 have been amended to recite antecedent basis for the limitation "the user" in Claims 5, 43, 81, and 119.

CLAIM REJECTIONS UNDER 35 U.S.C. §101.

In the Office Action, the Examiner rejected Claims 39-46, 60, 62, 63, 115-122, 136, 138, and 139 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

The Examiner's rejections under 35 U.S.C. §101 have been carefully considered. Claims 39, 77, and 115 have been amended to resolve the Examiner's rejections under 35 U.S.C. §101.

CLAIM REJECTIONS UNDER 35 U.S.C. §102(e).

In the Office Action, the Examiner rejected Claims 1-10, 22-27, 39-48, 60-65, 77-86, 98-103, 115-124, and 136-141 under 35 U.S.C. §102(e) as being anticipated by Stenz, U.S. Patent No. 6,754,637 ("Stenz ").

The Examiner's rejections under 35 U.S.C. §102(e) have been carefully considered. In response to the Examiner's rejections under 35 U.S.C. §102(e), it

is respectfully submitted, for the reasons given below, that _Stenz_ does not anticipate Claims 1-10, 22-27, 39-48, 60-65, 77-86, 98-103, 115-124, and 136-141.

It is respectfully submitted that the filing date of _Stenz_ does not precede the priority date of the earliest-filed provisional application to which the present application claims priority. The filing date of _Stenz_ is April 21, 2000. The earliest-filed provisional application (U.S. Provisional Application No. 60/192,692; the "_'692 Application_") to which the present application claims priority was filed on March 28, 2000.

It is respectfully submitted, for the reasons described below, that the _'692 Application_, the filing date of which pre-dates the filing date of _Stenz_, disclosed all of the features for which _Stenz_ is cited by the Examiner and further, supports the claims of the present application. A courtesy copy of the specification of the _'692 Application_ is attached to this Amendment and Response for the Examiner's convenient reference of the citations provided below.

The Examiner found that _Stenz_ discloses the use of an online merchandise return computer system. It is respectfully submitted that the _'692 Application_ disclosed the use of an online merchandise return computer system. See, e.g., _'692 Application_, Abstract.

The Examiner found that _Stenz_ further disclosed that the computer is programmed to save a set of return rules input by a merchant. It is respectfully submitted that the _'692 Application_ disclosed programming a computer to save a set of return rules input by a merchant. See, e.g., _'692 Application_, page 17, lines 19-26.

The Examiner found that _Stenz_ further disclosed that the computer is programmed to receive a return request by a consumer. It is respectfully submitted that the _'692 Application_ disclosed programming a computer to receive a return request by a consumer. See, e.g., _'692 Application_, page 28, line 26 - page 29, line 34.

The Examiner found that _Stenz_ further disclosed that the computer is programmed to process a return request according to the set of return rules. It is

respectfully submitted that the *'692 Application* disclosed programming a computer to process a return request according to the set of return rules. *See, e.g., '692 Application,* page 29, lines 25-34.

The Examiner found that *Stenz* further disclosed the use of a set of return questions and processing the return according to the rules. It is respectfully submitted that the *'692 Application* disclosed the use of a set of return questions and processing the return according to the rules. *See, e.g., '692 Application,* page 29, lines 14-34.

The Examiner found that *Stenz* further disclosed that a list of carriers can be used. It is respectfully submitted that the *'692 Application* disclosed that a list of carriers can be used. *See, e.g., '692 Application,* page 37, lines 19-27.

Because the filing date of *Stenz* does not precede the priority date of the earliest-filed provisional application to which the present application claims priority, because, for the reasons given above, it is respectfully submitted that the *'692 Application* disclosed all of the features for which *Stenz* is cited by the Examiner, and because the *'692 Application* supports the claims of the present application, it is respectfully submitted that *Stenz* does not anticipate Claims 1-10, 22-27, 39-48, 60-65, 77-86, 98-103, 115-124, and 136-141.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a).

In the Office Action, the Examiner rejected Claims 11, 12, 27, 49, 50, 65, 87, 88,103, 125, and 126 under 35 U.S.C. §103(a) as being unpatentable over *Stenz* in view of Kara, U.S. Patent No. 6,233, 568 ("*Kara*"). The Examiner rejected Claims 13-21, 27, 51-59, 65, 89-97, and 127-135 under 35 U.S.C. §103(a) as being unpatentable over *Stenz* and *Kara*, and further in view of UPS® Service Guide and FedEx® Service, and Barnett et al., U.S. Patent No. 6,369,840 ("*Barnett*").

The Examiner's rejections under 35 U.S.C. §103(a) have been carefully considered. In response to the Examiner's rejections under 35 U.S.C. §102(e), it is respectfully submitted, for the reasons given below, that Claims 11, 12, 27, 49,

50, 65, 87, 88,103, 125, and 126 are patentable over _Stenz_ and that Claims 13-21, 27, 51-59, 65, 89-97, and 127-135 are patentable over _Stenz_ and _Kara_.

It is respectfully submitted that the filing date of _Stenz_ does not precede the priority date of the earliest-filed provisional application to which the present application claims priority; it is respectfully submitted that the _'692 Application_ disclosed all of the features for which _Stenz_ is cited by the Examiner, and further, supports the claims of the present application.

The Examiner found that _Stenz_ discloses the use of selecting a carrier for shipment. It is respectfully submitted that the _'692 Application_ disclosed the use of selecting a carrier for shipment. _See, e.g., '692 Application_, page 37, lines 19-27.

The Examiner found that _Stenz_ and _Kara_ disclose an onscreen interactive display with a selection and comparison section for a plurality of carriers with a plurality of services. It is respectfully submitted that the _'692 Application_ disclosed an onscreen interactive display with a selection and comparison section for a plurality of carriers with a plurality of services. _See, e.g., '692 Application_, page 37, lines 11-27.

The Examiner cited _Stenz_ in relation to Claims 17, 55, 93 and 131, which recite, in one way or another, "generat[ing] an internal system tracking number for the return order; and sav[ing] said internal system tracking number for the return order in a database." It is respectfully submitted that the _'692 Application_ disclosed generating an internal system tracking number for the return order; and saving said internal system tracking number for the return order in a database. _See, e.g., '692 Application_, page 13, lines 11-21; _see also, e.g., '692 Application_, page 31, lines 3-33.

The Examiner cited _Stenz_ in relation to Claims 19, 20, 57, 58, 95, 96, 133 and 134, all of which are directed, in one way or another, to a "printable shipping label." It is respectfully submitted that the _'692 Application_ disclosed a printable shipping label. _See, e.g., '692 Application_, page 29, line 32; _see also, e.g., '692 Application_, page 32, lines 7-31.

The Examiner cited *Stenz* in relation to Claims 21, 59, 97, and 135, all of which are directed, in one way or another, to a "tracking report record." It is respectfully submitted that the *'692 Application* disclosed a tracking report record. *See, e.g., '692 Application*, page 58, lines 14-34; see also, e.g., *'692 Application*, page 59, line 3 - page 60, line 36.

Because the filing date of *Stenz* does not precede the priority date of the earliest-filed provisional application to which the present application claims priority, because, for the reasons given above, it is respectfully submitted that the *'692 Application* disclosed all of the features for which *Stenz* is cited by the Examiner, and because the *'692 Application* supports the claims of the present application, it is respectfully submitted that Claims 11, 12, 27, 49, 50, 65, 87, 88,103, 125, and 126 are patentable over *Stenz* and that Claims 13-21, 27, 51-59, 65, 89-97, and 127-135 are patentable over *Stenz* and *Kara*.

CONCLUSION

In view of the foregoing reasons, it is respectfully submitted that the invention disclosed and claimed in the present amended application is not fairly taught by any of the prior art references of record, taken either alone or in combination, and that the application, as amended, is in condition for allowance. Accordingly, it is respectfully requested that the present application be reconsidered and allowed.

Respectfully submitted,

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